

Serial No. : 09/498,893
Docket No.: ST97001CI1 (209-US-CI1)

REMARKS

RECEIVED
CENTRAL FAX CENTER

JAN 26 2007

Claims 1, 2, 5-9, 11, 12, 14, 15, 17-23, 26-29, 39-42 and 44 are pending in this application after amending claims 1, 9, 15, 22, 39 and 44. Applicants believe that no new matter has been added by this response.

Response to Claim Objections

The Examiner raised objections to claims 1 and 15 because of informalities. Applicants have amended claims 1 and 15 in order to address the informalities raised by the Examiner. Applicants now believe that claims 1 and 15 are in condition for allowance.

Response to Nonstatutory Obviousness-Type Double Patenting Rejection

Applicants are waiting to file a terminal disclaimer to overcome the nonstatutory obviousness-type double patenting until the final form of the claims has been reached. Until the final form of the claims are known, it is possible that they will be further amended and that no terminal disclaimer will be required.

Response to 35 U.S.C. §103(a) Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

Serial No.: 09/498,893

Docket No.: ST97001C11 (209-US-C11)

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The Examiner rejected claims 1, 2, 5, 8, 9, 11, 14, 15, 20, 22, 23, 26 and 29 under 35 U.S.C. 103(a) as being unpatentable over Krasner et al. (US Patent 6,289,041 hereafter the '041 patent) in view of Mendelovicz et al. (US Patent 6,005,903, hereafter the '903 patent). The combination of the '041 patent in view of the '903 patent fails to establish a prima facie case of obviousness.

Not all claim limitation taught or suggested by cited art

The prior art reference of the '041 patent in view of the '903, does not teach or suggest all of Applicant's claim limitations. Specifically, it fails to point out that the match filter is synchronized to T20 periods as claimed in claims 1, 9, 15 and 22 by Applicants.

Must be some suggestion or motivation to combine

A prima facie case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings of the '041 patent with the '903 patent. If claim limitations are missing from the teachings of the combined references, there can be no suggestion or motivation to make such a combination.

There must be a reasonable expectation of success

Prima facie obviousness requires that there must be a reasonable expectation of success when prior art is modified or combined. There is no reasonable expectation of

Serial No. : 09/498,893
Docket No.: ST97001CI1 (209-US-CI1)

success in achieving the invention claimed when the '041 patent, is modified with the teachings of the '903 patent. Such a modification of the '041 patent, if such a modification was even possible, would still not contain all of the Applicant's limitations.

Similarly, that above argument is reiterated herein for all of the other claims that have been rejected under 35 U.S.C §103(a) that rely on the '041 patent being combined with other reference. Thus, all of the other claims that have been rejected under 35 U.S.C. §103(a) are in condition for allowance (such as independent claim 39).

Therefore, amended independent claims 1, 9, 15, 22, and 39 are in condition for allowance along with any dependent claims that depend from them.

Serial No. : 09/498,893
Docket No.: ST97001C11 (209-US-C11)

RECEIVED
CENTRAL FAX CENTER

JAN 26 2007

Conclusion

In view of the foregoing discussion and amendments, Applicants respectfully submit that claims 1, 2, 5-9, 11, 12, 14, 15, 17-23, 26-29, 39-42 and 44 as presented are in a condition for allowance, for which action is earnestly solicited.

Respectfully submitted,
THE ECLIPSE GROUP LLP

By: 
Gregory B. Gulliver, Reg. 44,138

Phone: (847) 282-3551
Fax: (818) 332-4205

Customer No.: 34408